UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/685,189	10/06/00	HEINRICHS V	02-101510US

022798 HM12/1102
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EXAMINER	
ANDRES, J	
ART UNIT	**PAPER NUMBER**
1646	9

DATE MAILED: 11/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/685,189	HEINRICHS ET AL.	
	Examiner	Art Unit	
	Janet L Andres	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-148* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-148* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-30, 66, 67, 89-92, 104, and 106-119, drawn to polynucleotides and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325.

II. Claims 31-63, 105, 120, 121, 124-132, 147, and 148, drawn to polypeptides, classified in class 530, subclass 350.

III. Claims 64, 65, and 133, drawn to antibodies, classified in class 530, subclass 388.1 and 389.1.

IV. Claims 68-70, and 134-136, drawn to a method of inhibiting tumor growth, classified in class 514, subclass 2.

V. Claims 71-76, and 137-142, drawn to methods of inhibiting viral replication, classified in class 514, subclass 2.

VI. Claims 77-80, and 143-145, drawn to methods of treatment of autoimmune disorders, classified in class 514, subclass 2.

VII. Claims 81-88, and 122, drawn to libraries and methods of making them, classified in class 435, subclass 69.1.

VIII. Claims 93-103, drawn to integrated systems and methods of use, classified in class 700, subclass 96.

IX. Claim 123, drawn to a protein derived from a nucleic acid library, classified in class 530, subclass 350.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are distinct from each other because they are chemically and physically distinct entities with different structures, functions, and uses.

Inventions I and III are unrelated. The polynucleotides of Invention I can not be used to generate the antibodies of Invention III, and the antibodies of Invention III can not be used to purify or detect the polynucleotides of Invention I.

Invention I is not related to the methods of Inventions IV, V, or VI. The polynucleotides of Invention I can not be used in any of these methods.

Invention I is distinct from Invention VII because the polynucleotides of Invention I are individual molecules with defined structural characteristics while the Invention VII is drawn to libraries and populations with related characteristics and methods of producing same.

Invention I is distinct from Invention VIII because the polynucleotides of Invention I are individual chemical entities while Invention VIII is a database.

Invention I is distinct from Invention IX because they are chemically and physically distinct entities with different structures, functions, and uses.

Inventions II and III are distinct because they are different entities with different binding characteristics and different associated structural features.

Invention II is distinct from Inventions IV, V, and VI because the polypeptides of Invention I have other uses, such as the generation of antibodies.

Invention II is unrelated to Inventions VII and VIII because Invention II is drawn to polypeptides, while Inventions VII and VIII are drawn to methods and systems involving

polynucleotides, which are chemically and physically distinct entities with different structures, functions, and uses.

Invention II is distinct from Invention IX because the polypeptides have different sequences and thus different structural and functional properties.

Invention III is unrelated to the methods of Inventions IV, V, and V. The antibodies of Invention III can not be used in any of these therapeutic methods.

Invention III is unrelated to Inventions VII and VIII because Invention III is drawn to antibodies, while Inventions VII and VIII are drawn to methods and systems involving polynucleotides, which are chemically and physically distinct entities with different structures, functions, and uses.

Inventions II and IX are distinct because they are different entities with different binding characteristics and different associated structural features.

Inventions IV, V, and VI are distinct because they are drawn to methods of treating different conditions and thus have different concerns relating to the specific characteristics of each disease, and different outcome measures.

Invention IV, V, and VI are unrelated to Inventions VII and VIII. The polynucleotides and methods of Invention VII can not be used in the methods of Inventions IV, V, and VI, which are drawn to proteins therapy, and the integrated systems of Invention VIII have no applicability to the therapeutic methods of Inventions IV, V, and VI.

Invention IX is distinct from Inventions IV, V, and VI because the polypeptides of Invention IX have other uses, such as the generation of antibodies.

Inventions VII and VIII are distinct because Invention VII is drawn to libraries and methods of generating same and thus has entirely different concerns and requirements than Invention VIII, which is drawn to a database of existing sequences.

Invention Ix is unrelated to Inventions VII and VIII because Invention I is drawn to polypeptides, while Inventions VII and VIII are drawn to methods and systems involving polynucleotides, which are chemically and physically distinct entities with different structures, functions, and uses.

Because these inventions are distinct for the reasons given above different searches are required for the different groups, restriction for examination purposes as indicated is proper.

Inventions I-VII are generic to a plurality of disclosed patentably distinct species comprising the individual sequences listed by SEQ ID NO and the variants of claim 3 or 34. If any of these inventions are elected applicant is required under 35 U.S.C. 121 to elect a single disclosed species, identified either by SEQ ID NO or as a single sequence that is one of the possible variants of claims 3 or 34, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Andres, Ph.D., whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564. The fax phone number for this group is (703) 305-3014 or (703) 308-4242.

Communications via internet mail regarding this application, other than those under U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[yvonne.eyler@uspto.gov]**.

All Internet email communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet Andres, Ph.D.
October 24, 2001

YVONNE EYLER, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600